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REMARKS

Applicant has reviewed and considered the Office Action mailed on May 8, 2006, and the references cited therewith. Applicant respectfully requests reconsideration and allowance of all claims in view of the following remarks.

Claims 15-27 are currently pending. Claims 15, 23 and 24 are amended.

Claims 15-19 and 25 patentable over Jiang under §102

Claims 15-19 and 25 were rejected under 35 U.S.C. §102(e) as being anticipated by Jiang et al. (U.S. 6,741,853B1, hereinafter "Jiang").

According to MPEP §2131, to anticipate a claim under §102, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Jiang fails to anticipate the claimed invention, because Jiang fails to teach every element of each claim. For example, Jiang fails to teach that one of the user devices is a DTV client.

Claim 15 recites, *inter alia*, "wherein one of the user devices is a DTV client".

Jiang fails to teach the claimed DTV client. Jiang fails to disclose any television or cable services. The cellular phone, radio, and telecommunications services described in Jiang operate differently than the television or cable services disclosed in

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the present application. (See Jiang, Figures 4-6.) The Examiner admits that Jiang does not teach a DTV client. (See Office Action, page 7.)

Therefore, claim 15 is patentable over Jiang under §102.

Claims 16-27 depend, directly or indirectly, from claim 15 and, thus, inherit the patentable subject matter of claim 15, while adding additional elements and further defining elements. Therefore, claims 16-27 are also patentable over Jiang under §102 for at least the reasons given above with respect to claim 15.

Claims 20-22 patentable over Jiang/Desrochers under §103

Claims 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of U.S. Patent No. 6,553,405 to Desrochers ("Desrochers").

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A *prima facie* case of obviousness has not been established for claims 20-22, because the combination of Jiang and Desrochers fails to teach or suggest all the claim elements. For example, the combination fails to teach or suggest that one of the user devices is a DTV client, as claimed. The Examiner admits that Jiang does not teach a DTV client. (See Office Action, page 7.) Claims 20-22 are patentable over Jiang under §102 for at least the reasons given above with respect to claim 15. In addition, Desrochers also fails to teach or suggest a DTV client. Therefore, claims 20-22 are patentable over the combination of Jiang and Desrochers under §103.

Claims 23 and 24 patentable over Jiang/Kessler under §103

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Claims 23 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of U.S. Patent No. 6,621,528 B1 to Kessler et al. ("Kessler").

A *prima facie* case of obviousness has not been established for claims 23 and 24, because there is no suggestion or motivation in Jiang or Kessler or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure.

There is a lack of suggestion to combine the references. Kessler teaches a DTV control system in a television set itself and Jiang does not include a television set; therefore, there is no television set in Jiang to modify to include the DTV control system of Kessler. Kessler states that a DTV control system "may form a part of a digital television set itself, a digital television adapter or a set-top box (STB), or any other device including DVD players and video cassette recorders, which incorporate an internal tuning mechanism." (See Kessler, col. 3, lines 53-59.) Kessler's intended purpose is a method and system for tuning a digital television for digital video broadcast format video. (See Kessler, abstract.) Jiang fails to disclose any digital television set, digital television adapter, set-top box, or any other device including DVD players and videocassette recorders. The claimed invention is a client server system (i.e., a DTV client and a digital identity server), while the proposed combination is not (i.e., Kessler's television set including a DTV control system). Kessler does not suggest a client server system. Furthermore, Jiang's mere general statement of having more than one alternative embodiment does not suggest the proposed combination. (See Jiang, col. 1, line 21 to col. 2, line 25, col. 6, lines 57-60.) Jiang fails to suggest adding a television set that specifically includes the features of Kessler. The conventional television service in Kessler is dissimilar from the services in Jiang cited by the Examiner, namely, voice mail, e-mail, personal information management, internet access services, and evolving technologies. (Jiang, col. 6, lines 51-64.)

Therefore, claims 23 and 24 are patentable over the combination of Jiang and Kessler under §103.

Claims 15-27 patentable over Jiang/Kessler under §103

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For the same reasons given above with respect to claims 23 and 24, claims 15-27 are also patentable over the combination of Jiang and Kessler. Claim 15 recites, *inter alia*, "a digital identity server coupled to the database and the command server and including at least two adapters for at least two types of user device" and "wherein one of the user devices is a DTV client". There is no suggestion or motivation in Jiang or Kessler to modify the references to achieve such a client server system. In addition, there is no teaching of a television set in Jiang to modify to include the DTV control system of Kessler, as discussed above. However, Applicants' disclosure does teach and suggest the claimed invention, but it is improper for the Examiner to use Applicants' disclosure in this way. Claims 16-27 depend, directly or indirectly, from claim 15 and, thus, inherit the patentable subject matter of claim 15, while adding additional elements and further defining elements. Therefore, claims 16-27 are also patentable over the combination of Jiang and Kessler under §103.

Claims 26 and 27 patentable over Jiang/Jindal under §103

Claims 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of U.S. Patent No. 6,092,178 to Jindal et al. ("Jindal").

Claims 26 and 27 are patentable over Jiang under §102 for the reasons given above with respect to claim 15. Furthermore, the combination of Jiang and Jindal fails to establish a *prima facie* case of obviousness, because the combination fails to teach or suggest that one of the user devices is a DTV client, as claimed. The Examiner admits that Jiang does not teach a DTV client. (See Office Action, page 7.) In addition, Jindal also fails to teach or suggest a DTV client.

Therefore, claims 26 and 27 are patentable over the combination of Jiang and Jindal under §103.


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CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Lea Nicholson or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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